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Docket No.: 28564.003.00  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**

JUL 02 2004

**OFFICE OF PETITIONS**

In re Patent Application of:  
Lothar E.S. Budike, Jr.

Application No.: 09/299,124 ✓

Customer No.: 30827

Filed: April 26, 1999

Art Unit: N/A

For: MULTI-UTILITY ENERGY CONTROL  
SYSTEM WITH A PLURALITY OF  
INTERFACE GATEWAYS

Examiner: Brian Hearn

**REQUEST FOR RECONSIDERATION**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Decision (Paper No. 12) on the renewed petition under 37 CFR 1.137(b), filed December 8, 2003, to revive the above-identified application (Paper No. 10), the Applicant requests reconsideration in view of the following remarks.

By this Request, the Applicant submits herewith a Third Declaration of Lothar E.S. Budike, Jr., as well as Exhibits A-C, which provide support for the statements contained in the Third Declaration, to properly respond to the Dismissal mailed by the Patent Office on April 30, 2004.

Applicant notes that per the Petition Examiner's request, a letter was sent to Mr. Kenneth Glynn requesting information as "to why action was not taken to prevent the application from becoming abandoned while the application was under" his control. Mr. Glynn's response is enclosed. (See Exhibit D).

In view of the above, the present application is in condition for continued examination. Accordingly, the Examiner is requested to pass this application to the appropriate art unit for examination.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. § 1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: June 30, 2004

Respectfully submitted,

By 

Mark R. Kresloff

Registration No.: 42,766

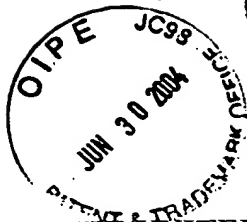
MCKENNA LONG & ALDRIDGE LLP

1900 K Street, N.W.

Washington, DC 20006

(202) 496-7500

Attorney for Applicant



Docket No.: 28564.003.00-US  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Lothar E.S. BUDIKE, Jr.

Application No.: 09/299,124

Filed: April 26, 1999

For: MULTI-UTILITY ENERGY CONTROL AND  
FACILITY AUTOMATION SYSTEM WITH  
DASHBOARD HAVING A PLURALITY OF  
INTERFACE GATEWAYS

Art Unit: 2161

Examiner: Thomas A. Dixon

**RECEIVED**

JUL 02 2004

**OFFICE OF PETITIONS**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**THIRD DECLARATION OF LOTHAR E.S. BUDIKE, JR.**

I, Lothar E.S. Budike, Jr., declare as follows.

1. I am the sole inventor of the subject matter claimed in the above-identified patent application, which has a filing date of April 26, 1999.
2. I assigned all of my rights in this application, including any patent issuing there from, to Powerweb, Inc ("Powerweb").
3. From the time this application was filed, on April 26, 1999, to the present, without interruption, I have been the President and Chief Executive Officer (CEO) of Powerweb. As President and CEO, I have always had and continue to have full authority to

act on behalf of Powerweb on all intellectual property matters, including all matters relating to the prosecution of this patent application.

4. On October 2, 2001, the United States Patent and Trademark Office mailed out an Office Action relating to the present application. Sometime after the October 2, 2001 Action was mailed, I received correspondence from my former patent counsel, Mr. Kenneth Glynn, indicating the costs associated with responding to the Office Action. Per our procedures, upon receiving payment covering the costs, Mr. Glynn would file the necessary response with the Patent Office without further instructions from me. Accordingly, as I stated in my earlier declaration dated June 6, 2002 (Exhibit A), I did not explicitly direct Mr. Glynn to file a response to the Office Action, as it was my understanding that he would do so upon receiving payment covering those costs.

5. Subsequent to receiving Mr. Glynn's correspondence indicating the costs associated with preparing and filing a response to the October Office Action, I exercised my authority by instructing our accounting department to send a payment to Mr. Glynn to cover those costs.

6. Previously, I personally sent payments to Mr. Glynn. However, prior to receiving Mr. Glynn's correspondence indicating the costs associated with preparing and filing a response to the October Office Action, there was a change in procedures at Powerweb. As a result, Powerweb's accounting department was to handle the processing of all payments, including those to Mr. Glynn. No one in the accounting department had any authority to make decisions regarding the instant application or any other application. With

regard to patent matters, they were charged only with administration of the payments to Mr. Glynn.

7. As stated above, I instructed our accounting department to send a payment to Mr. Glynn to cover the costs associated with preparing and filing a response. Also, as stated in my Second Declaration, dated December 4, 2003, Powerweb had another, co-pending patent application (Serial No. 09/628,855). Confusing the present application with the co-pending application, a payment was never sent to our attorney per my instructions, as there was no action required in the co-pending application. Consequently, Mr. Glynn did not prepare and/or file a response.

8. I first learned that the present patent application was abandoned during a telephone conversation with Mr. Glynn in early May 2002. Mr. Glynn explained that because the application was abandoned unintentionally, we could petition the Patent Office to revive the application. Under my instruction, he prepared and filed a Petition on June 6, 2002 (Exhibit B). The Petition was accompanied by my earlier Declaration, also dated June 6, 2002; a Petition fee pursuant to 37 CFR 1.17(m); a Response to the outstanding Office Action along with a 3 month Extension of Time fee pursuant to 37 CFR 1.17(a); and a Terminal Disclaimer along with the Terminal Disclaimer fee pursuant to 37 CFR 1.20(d).

9. On August 5, 2002, the Patent Office issued a Decision dismissing the Petition (Exhibit C). I was unaware of this Decision until November 2002.

10. On or about November 12, 2002, I received a letter dated November 12, 2002 from Mr. Glynn indicating that the Petition had been dismissed and that I should file a

Continuation-in-Part (CIP) based on the co-pending application in order to pursue protection of my invention. In addition, he provided an indication of the costs associated with filing the CIP application.

11. In the November 12, 2002 letter, Mr. Glynn suggested there was an earlier telephone call during which he informed me of the Decision dismissing the Petition. This is incorrect.

12. Soon after I received the November 12, 2002 letter, I had a telephone conversation with Mr Glynn. During this telephone conversation, I terminated the relationship with Mr. Glynn.

13. Based on the November 12, 2002 letter and the subsequent telephone conversation with Mr. Glynn, I was under the mistaken belief that the present application was no longer revivable. With respect to a CIP application, I intended to acquire new counsel prior to proceeding with any such application.

14. In November 2003, I engaged new (now present) counsel. During a meeting with our present counsel, I learned there was still an opportunity to revive the present application, as we never at any time intended to abandon this application.

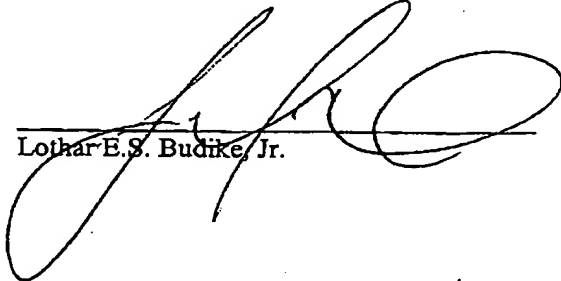
16. After meeting with our present counsel, I obtained my previous attorney's files relating to the present patent application and the aforementioned, co-pending patent application. The delay from December 2002 to November 2003 resulted from various factors.

First, I had difficulty obtaining my files from Mr. Glynn. Second, I was unaware that the instant application could be revived.

17. In late November 2003, in response to our unintentional abandonment of the present patent application, and the unintentional failure to file a timely Request for Reconsideration in response to the August 5, 2002 Decision dismissing our prior Petition to Revive, I instructed my present counsel to prepare and file a Request for Consideration.

20. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: June 29, 2004

  
Lothar E. S. Budike, Jr.

# EXHIBIT A



SF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

LOTHAR E.S. BUDIKE, JR.

Serial No. 09/299,124

Filing Date: April 26, 1999

For: Multi-Utility Energy Control and  
Facility Automation System With  
Dashboard Having a Plurality of  
Interface Gateways

:  
:  
: Examiner:  
:  
: Thomas A. Dixon  
:  
: Group Art Unit: 2161  
:  
: Attorney Docket No.: PWB-119C

Honorable Commissioner of Patents and Trademarks  
Washington, DC 20231

DECLARATION OF LOTHAR E.S. BUDIKE

I, Lothar E.S. Budike, declare as follows:

1. I am the inventor in the above-identified patent application.
2. I did not direct my attorney to file a Response in this application in a timely fashion because the application has been assigned to Powerweb, Inc. I was the President of the company and handling payments on all patent matters. Prior to the due date of the Response, I was removed from some financial and management responsibilities and directed the new people in charge to send payment to my attorney and have him file a timely Response with a Terminal Disclaimer and proper fee. When they looked at their records they confused two different patent applications and failed to contact the attorney, because the other application had already been taken care of. As soon as I discovered the

error, I corrected the problem and the proper Response is attached hereto.

Thus, the application went abandoned unintentionally.

3. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: June 6, 2002

Respectfully Submitted,

  
Lothar E.S. Budike

KPG/dm  
cc: Lothar E.S. Budike  
EM RRR No. EU 424804635 US

# EXHIBIT B

Sf

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	:
LOTHAR E.S. BUDIKE, JR.	: Examiner:
Serial No. 09/299,124	: Thomas A. Dixon
Filing Date: April 26, 1999	: Group Art Unit: 2161
For: Multi-Utility Energy Control and Facility Automation System With Dashboard Having a Plurality of Interface Gateways	: Attorney Docket No.: PWB-119C

Honorable Commissioner of Patents and Trademarks  
Washington, DC 20231

PETITION TO REVIVE BASED ON UNINTENTIONAL ABANDONMENT

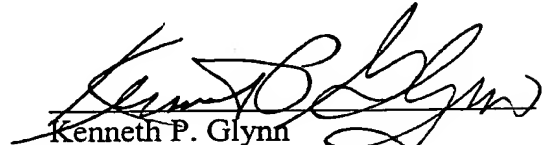
Applicant hereby petitions for the revival of the present application and withdrawal of abandonment on the basis that the abandonment was unintentional. In support thereof, attached hereto are the following:

1. Certification of Lothar E.S. Budike in support of unintentional abandonment;
2. Petition fee of \$640.00; and,
3. Amendment and Response, Submission of Formal Drawings, Terminal Disclaimer and Terminal Disclaimer fee of \$55.00.

It is believed that the above attachments and enclosures adequately support a favorable resolution of applicant's Petition to Revival and an early and favorable response is earnestly solicited.

Respectfully Submitted,

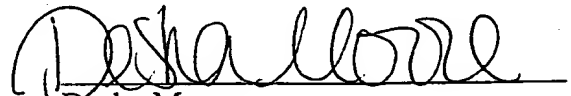
Dated: June 6, 2002

  
Kenneth P. Glynn  
Registration No. 26,893  
Attorney for Applicant  
24 Mine Street  
Flemington, NJ 08822  
(908) 788-0077 Tele  
(908) 788-3999 Fax

KPG/dm  
cc: Lothar E.S. Budike  
EM RRR No. EU 424804635 US

CERTIFICATION OF EXPRESS MAILING

The undersigned hereby certifies that this document was delivered to the United States Post Office in Flemington, New Jersey 08822 between 8:30 a.m. and 4:30 p.m. on Thursday, June 6, 2002. The undersigned further declares that this Certification is made with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under application sections of United States law and that willful false statements made before the United States Patent and Trademark Office may jeopardize the validity of the application or issuing patent related thereto.

  
Desha Moore

KPG/dm  
EM RRR No. EU 424804635 US  
(PWB-119C)

# EXHIBIT C



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

Paper No. 10

KENNETH P. GLYNN ESQ  
24 MINE STREET  
FLEMINGTON NJ 08822-1516

COPY MAILED

AUG 05 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of  
Lothar E.S. Budike Jr.  
Application No. 09/299,124  
Filed: April 26, 1999  
Attorney Docket No. PWB-119C

This is a decision on the petition under 37 CFR 1.137(b), filed June 6, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action remailed on October 2, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 3, 2002.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item (3).

W. A. Johnston  
checked  
1305-  
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Applicant, Lothar E.S. Budike, states:

I did not direct my attorney to file a Response in this application in a timely fashion because the application has been assigned to Powerweb, Inc. I was President of the company and handling payments on all patent matters. Prior to the due date of the Response, I was removed from some financial and management responsibilities and directed the new people in charge to send payment to my attorney and have him file a timely Response with a Terminal Disclaimer and proper fee. When they looked at their records they confused two different patent applications and failed to contact the attorney, because the other application had already been taken care of.

37 CFR 1.137(b) provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petition must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification "unintentional" for the reply to now be accepted on petition. The current showing of record raises a question as to whether the delay in filing the reply within the time period set in the Office action on October 2, 2001 was in fact unintentional as to the party having interest in the instant application.

The showing of record is that applicant, Mr. Budike, was removed from some of his financial and management responsibilities in view of the assignment of the application to Powerweb, Inc. Therefore, it is unclear whether Mr. Budike was the party in interest having apparent authority to direct the prosecution of the instant application. When the issue of revival is addressed, the focus must be on the rights of the parties as of the time of abandonment. See Kim v. Quigg, 781 F.Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va 1989). It is noted that applicant Budike assigned his interests in this application to Powerweb, Inc. on April 12, 1999. Therefore, applicant, as the assignor of his interest, could not demand that the assignee prosecute this case. As noted in MPEP 711.03(c), the question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not to reply) was unintentional). From the statements presented, it is unclear as to who was the proper party in

interest in the instant matter and as to who was responsible for making decisions as to the prosecution of the instant application. In view of the above, further clarification is required as to the party having apparent authority to direct the prosecution of the instant application. Further, an explanation as to the unintentional delay in replying to the outstanding Office action of October 2, 2001 should be provided from the parties responsible for the delay.

**In order to expedite revival of this application, petitioner may wish to consider submitting the items required by this decision on petition in a renewed petition under 37 CFR 1.137(b) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.**

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By facsimile: (703) 308-6916  
Attn: Office of Petitions

By hand: Office of Petitions  
2201 South Clark Place  
Crystal Plaza 4, Suite 3C23  
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.



Frances Hicks

Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

# EXHIBIT D



**GLYNN & ASSOCIATES, P.C.**  
ATTORNEYS AT LAW

KENNETH P. GLYNN, ESQ.  
Bars: New Jersey, Federal, Conn.,  
U.S. Patent & Trademark Office

DEIRDRA M. MEAGHER, ESQ.  
Bars: New Jersey, Federal  
U.S. Patent & Trademark Office

CYNTHIA V. PONTECORVO  
Licensing Liaison

STEVEN P. GLYNN  
Trademark & Corporate Liaison

Mailing Address:  
24 Mine Street  
Flemington  
New Jersey 08822

Telephone:  
(908) 788-0077

Telefax:  
(908) 788-3999

30 June 2004

Mr. Mark Kresloff  
McKenna Long & Aldridge LLP  
1900 K Street, NW  
Washington, DC 20006

Re: Patent Application Serial No. 09/299,124  
Your Reference 28564.003  
Our Reference No. PWB-119C

Dear Mr. Kresloff:

Further to your letter of June 23, 2004, enclosed is my response to the Petition Examiner's questions concerning the circumstances surrounding the abandonment, and revival of the above identified application.

As noted in your letter, the Petition Examiner set forth three specific questions regarding my involvement in the present application. My response to these questions is as follows:

- (1) The October 2, 2001 Office Action ("October Action") was docketed for reply in my electronic docketing system, PatentMate.
- (2) I have always communicated with Lou Budike, at Powerweb, Inc., concerning all patent matters, including the present application. It has always been my procedure to forward a copy of any office action to Mr. Budike, along with the cost for preparing and filing a response thereto. Mr. Budike would either send me a check covering the cost for a response, or would otherwise direct me to file a response. In accordance with my procedure, a copy of the October 2, 2001 Office Action, along with a letter stating the cost for preparing and filing a response, was forwarded to Mr. Budike by Certified Mail, of which receipt was acknowledged.

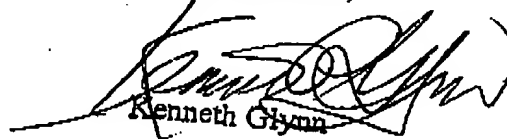
Page 2

As stated in Mr. Budike's Declaration in support of the initial petition to revive, Mr. Budike did not direct me to file a response, nor I did receive any payment associated therewith. Therefore, although a response to the October Action was docketed, I did not prepare and/or file a response to the Office Action because I interpreted Mr. Budike's lack of direction and lack of payment as his desire not to pursue this application.

(3) Upon receipt of the Decision to Dismiss the Petition dated August 5, 2002, I recommended filing a Continuation-in-Part application as opposed to requesting reconsideration of the petition to revive because I felt it was the least expensive and most likely to succeed course of action.

If I can be of any further assistance in this matter, please let me know.

Sincerely yours,

  
Kenneth Glynn